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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,684	10/22/2001	Thomas R. Wulff	83573RLO	7300

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,684

Applicant(s)

WULFF ET AL.

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 February 2005 has been entered.

Response to Amendment

On 22 February 2005, applicant filed an amendment, canceling claim 1 and adding claim 10. Claims 2-9 are amended.

Claims 2-10 are pending and will be examined.

Claim Rejections - 35 USC § 112

Claim 10 and claims dependent thereupon are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10(e) and (f) appear to refer to the same merging function that was previously found only in claim 1(d). It is not clear how (f) further limits claim 10(e).

Claim Objections

Claim 10 is objected to because of the following informalities:

Claim 10(d) refers to a central receiving agency ***selecting*** ...based upon correlation.... This limitation appears previously in claim 1(b), which refers to ***specifying*** ...based upon correlation...The disclosures refer to selecting sponsors based on [various]. The claim will be interpreted to mean selecting sponsors and then selecting sponsor images based on various criteria.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (US 6,732,152) in view of Fredlund et al. (US 5,666,215).

Lockhart discloses methods and systems for printing and delivering images from digital image files from one or more recipients.

As in claim 10(a), Lockhart discloses that a consumer may electronically transmit digital images to a server at a centralized location (applicant's central receiving agency); see, for example, references to uploading images and file creation, at least Col. 5, line 40-Col. 7, line 4. A consumer may also upload demographic information that identifies the consumer or recipient; see, for example, at least references to demographics, Col. 15, line 46-64. A consumer may transmit digital images from location(s) remote from a server on the network; see, for example, at least references to

customers at client devices sending images to servers over communication channels such as the Internet, Fig. 1 and related text. The receiving agency, at a server, receives and stores digital images and other information in memory. See, for example, at least references to mail service computer 110 and associated storage, including databases. See also at least references to Image collections stored in databases, at least Col. 7, lines 5-20. The central receiving agency provides locator information to locate the images after a customer uploads the images. See, for example, at least Fig. 3 and related text concerning links to various images, such as a customer's images.

As per claim 10(b), Lockhart discloses that advertisers, media collection providers, partners and other parties (applicant's sponsors) may electronically transmit at least one sponsor digital image from a remote location, over a communications channel such as the Internet, to a server at a centralized location (applicant's central receiving agency). See, for example, at least references to image collections, partner web sites, Col. 6, lines 53-64. As above, the central receiving agency provides locator information to locate the images after a sponsor uploads the images. See, for example, at least Fig. 3 and related text concerning links to various images.

As per claim 10(c), Lockhart discloses that a consumer may identify a particular stored image using the corresponding image locator information and the location of one or more recipients. See, for example, at least Fig. 3 and browse button 306. A browse button permits a consumer to browse and identify a particular image using an image's memory locator. See also at least references to recipient location indicators, such as New Home/Address links in Fig. 3.

As per claim 10(d), Lockhart discloses that a central agency may select one or more sponsor digital images based upon correlation of demographic information and demographic requirements of sponsors. See references to targeting advertisements by demographic criteria. Along with various images, including advertising images, sponsors may transmit demographic requirements identifying consumers and recipients. For Advertisers as sponsors, please see at least Col. 15, lines 46-63. Sponsors may specify at least some of their digital images, which based upon a correlation between a sponsor's demographic requirements and demographic information that was provided by a consumer, identify at least some of the sponsor's digital images. See, for example, at least references to geographically-targeted advertisements and advertisements based on consumer demographics at least in Col. 15, lines 23-Col. 16, line 24.

As per claim 10(e) and (f), Lockhart discloses merging into a digital file the consumer identified digital image and the corresponding sponsor digital images. See, for example, at least references to merging consumer images and sponsor images and text, at least Col. 10, lines 56-67.

As per claim 10(g), Lockhart discloses transmitting the corresponding merged digital file for the identified particular stored image in the memory and display such image and the merged information to the printing location of the consumer or identified recipients. See, for example, at least references to reviewing, Col. 11, line 53-Col. 12, line 40. A consumer may preview merged digital files at his printing location, home computer-client site via a web browser, for example. See also at least Fig. 4, item 404, which shows an image that may be previewed at a recipient's location.

As per claim 10(h), Lockhart discloses printing the merged image at the printing location corresponding to consumer-identified recipients. See at least Col. 14, lines 27-63. Lockhart discloses delivering printed merged images to locations corresponding to the recipients; see at least Delivery, Col. 14, lines 63-Col. 15, line 7. See also references to printing and sending a mail item, at least Col. 12, lines 14-41.

As per claim 10(i), Lockhart discloses sponsor(s) making at least partial payment to the central receiving agency for the printing and delivering the merged digital file. See, for example, at least references to advertising potential, partial or complete underwriting of postage by sponsors, at least Col. 15, line 65-Col. 16, line 16.

As per claim 10, Lockhart **does not** specifically disclose merging files and including them in a package. Fredlund discloses uploading and merging music or voice files, and delivering them to customers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

As per claim 10, Lockhart **does not** specifically disclose merging files and including them in a package. Fredlund discloses uploading and merging music or voice files, and delivering them to customers.

As per claim 2, Lockhart discloses that electronically transmitting and the identifying steps are preformed simultaneously. See, for example, at least Fig. 3 and browse button 306. A browse button permits a consumer to browse and identify a particular image using an image's memory locator. See also at least references to recipient location indicators, such as New Home/Address links in Fig. 3.

As per claim 3, Lockhart discloses that the recipient location information includes a distribution list originally resident in a personal computer or in a central server managed by the central receiving agency. See, for example, at least references to selecting destination addresses from address books, Fig. 2 and related text. See also Addressing, Col. 10, lines 40-55.

As per claim 4, Lockhart discloses that the recipient location information includes the address of each of the recipients and wherein the printed image is delivered by mail to the address of each of the recipients. For recipient addresses, see at least Addressing, address books, Fig. 2 and related text, and Col. 10, lines 40-55. The printed images are delivered by mail to recipient's addresses, as seen in Delivery, Col. 14, line 64-67. See also Fig. 1 and related text, including description of item 120, surface mail.

As per claim 5, Lockhart discloses that sponsor digital images may include advertising information. See at least references to advertisements, Fig. 3, related text and Col. 15, line 46-Col. 16, line 17.

As per claim 6, Lockhart discloses extracting demographic information from the recipient's address and correlating recipient demographic information to permit

particularizing of information included in the package sent to one or more recipients. See, for example, at least references to targeting advertisements to recipients based on demographic information such as geographic location of a recipient's address, at least Col. 15, line 46-Col. 16, line 16.

As per claim 7, Lockhart **does not** specifically disclose that a package may include a digital audio file. Lockhart discloses customizing cards for particular occasions, such as birthdays and anniversaries. **Fredlund** discloses uploading and merging music or voice files. See, for example, at least Fig. 1 and related text. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

As per claim 8, Lockhart discloses that the package includes a digital video. See, for example, at least references to video image capture, Col. 9, line 60-Col. 10, line 2. See also references to user graphic images such as might provided by a digital camera, motion video camera and others, at least Col. 4, line 42-Col. 5, line 9.

As per claim 9, Lockhart discloses that the central receiving agency provides bills or charges to the consumer and the sponsor for the printing and delivery of the

package. See, for example, at least references to account balances, postcard purchases, Col. 11, line 53-Col. 12, line 14.

Response to Arguments

Applicant's arguments filed 22 February 2005 have been fully considered but they are not persuasive.

Applicant argues that there is suggestion in Lockhart for based upon correlation to select the appropriate sponsor. In response, the Examiner notes that The disclosures refer to selecting sponsor digital images based upon correlation of two sets of data, demographic information provided by consumers and sponsor's demographic requirements.

Applicant argues that he fails to see how Fredlund can in any way be combined with Lockhart to disclose or suggest new claim 10. In response, the Examiner notes that a "traverse" is a denial of an opposing party's allegations of fact.¹ The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common

¹ Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

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knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03
Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following are admitted prior art::

...it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP
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10 May 2005


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